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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/599,174	06/22/2000	Trevor Hamilton	ACC0786P1US	7590

7590 03/26/2002

Joan M McGillicuddy
Akzo Nobel Inc
Intellectual Property Department
7 Livingstone Avenue
Dobbs Ferry, NY 10522-3408

EXAMINER

CROCKFORD, KIRSTEN ANNE

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 03/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/599,174

Applicant(s)

HAMILTON ET AL.

Examiner

Kirsten Crockford

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☒ Interview Summary (PTO-413) Paper No(s). 9.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Priority

1. A certified copy of the foreign priority document must be provided by the applicant if the parent international application has not entered the national stage under 35 U.S.C. 371. See MPEP 1895.01.

Response to Arguments

2. The 35 USC 102(b) rejection over Wegehaupt et al. has been withdrawn in response to Applicant's arguments. Additionally, the claims are no longer rejected over WO 93/13179 in view of the Wegehaupt reference.

3. With respect to the 35 USC 112 rejections, Applicant argues that one skilled in the art would understand these terms in the claims would not read them as limitations as to the scope of the claims, especially when read in light of the specification. The Examiner maintains the rejections over claims 4, 5, 9, and 30. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required,

or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949).

4. With respect to the 35 USC 102(b) rejection of claim 30 over WO 93/13179, Applicant argues that the procedure of WO '179 results in a single coating layer in which the outermost surface region is rich in (B), whereas the innermost region is rich in (A). Applicant states that this indicates a diffusion pattern throughout the cured single coating layer. Applicant argues that the process of the instant application results in two layers which are connected to each other through condensation reaction at the interface. It is the Examiner's position that, in applying two coatings directly on each other as in the instant application, some diffusion will inherently take place between the two coating layers. Additionally, it is noted that the claim reads on applying the coatings wet-on-wet where diffusion between the layers would be even more prevalent. It is maintained that the processes appear to result in essentially materially similar final products, where there is unreacted component (A) near the inner surface, reacted components (A) and (B) in the middle, and unreacted component (B) near the outer surface of the coating layer(s).

With respect to the 35 USC 103(a) rejection of the claims over WO 93/13179, Applicant argues that there is no suggestion or indication in WO 93/13179 that component (A) and component (B) could be applied without mixing. While this is acknowledged, the Examiner notes that the instant claims are broad enough to read on applying two layers of WO '179's coating composition, one applied on top of the other, such as two overlapping/overlying brush, roller, or spray painting strokes. (It is noted that WO '179 teaches that its composition may be applied by brush-painting, roller-painting, or spray-painting on page 21.) In this case, the first

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layer inherently comprises component (A) and the second layer inherently comprises component (B). The transitional term “comprising,” which is synonymous with “including,” “containing,” or “characterized by,” is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 229 USPQ 805 (Fed. Cir. 1986); *In re Baxter*, 656 F.2d 679, 686, 210 USPQ 795, 803 (CCPA 1981); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 948) (“comprising” leaves “the claim open for the inclusion of unspecified ingredients even in major amounts”). Condensation curing would inherently occur between components (A) and (B) in the two thin coating layers. It is the Examiner’s position that it would have been obvious to have applied two thin layers of WO ‘179’s coating by brush, roller, or spray painting in place of one thicker layer with the expectation of similar and successful results. In general, the transposition of process steps or the splitting of one step into two, where the processes are substantially identical or equivalent in terms of function, manner and result, was held to not patentably distinguish the process. *Ex parte Rubin*, 128 USPQ 440 (Bd. Pat. App. 1959).

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 4, 5, 10, and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The use of “preferably” in claim 4, lines 5 and 7; in claim 5, “preferably” in line 6, “more especially” and “especially” in line 7, and “for example” in line 8; in claim 10, “preferably” and “more especially” in line 3; and in claim 30, “more especially” in line 2 renders the claims vague and indefinite. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired.

Claim Rejections - 35 USC § 102

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 30 and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 93/13179.

Claim 30 remains rejected for the same reasons set forth in paragraph 5 of the prior rejection, and for the reasons discussed above in paragraph 4. New claim 34 is rejected for the same reasons as claim 30.

Claim Rejections - 35 USC § 103

9. Claims 1-29 and 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 93/13179.

WO 93/13179 is applied for the same reasons discussed in paragraph 8 of the prior rejection. The claims are rejected for the reasons discussed above in paragraph 5. New claims 31-33 are rejected for the same reasons as claims 4, 5, and 10.

Conclusion


10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

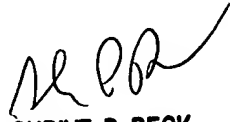
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kirsten Crockford whose telephone number is 703-306-5461. The examiner can normally be reached on Monday to Thursday and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on 703-308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1193.

kac 
March 22, 2002


SHRIVE P. BECK
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700